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SUITE 2800
DALLAS TX 75201-2784

In re Application of: Mark Lesswing et al.	:	DECISION ON PETITION
Application No. 09/577,386	:	TO WITHDRAW
Filed: May 23, 2000	:	THE RESTRICTION
For: NOVEL METHOD AND	:	REQUIREMENT
APPARATUS FOR REPRICING	:	UNDER 37 C.F.R. 1.181
A REIMBURSEMENT CLAIM	:	
AGAINST A CONTRACT	:	

This is in response to the petition filed on December 2, 2005 under 37 C.F.R. 1.181 requesting the withdrawal of the restriction requirement made in the office action of September 21, 2005.

The petition is **GRANTED**.

The present patent application was filed May 23, 2000 with 59 claims, numbered 1-59. A first Office Action, which included an examination of all 59 claims, was mailed August 27, 2003. In response, Applicant submitted an Amendment on November 13, 2003. A final Office Action, which again included an examination of all 59 claims, was mailed February 13, 2004. On June 14, 2004, Applicant filed a Request for Continued Examination with an accompanying amendment, which included previously examined claims 1-59 and added new claims 60-86, thus resulting in claims 1-86 pending in the application. The September 21, 2004 Office Action required restriction between the following claim groups: I. Claims 1-11 and 24-70, II. Claims 12-23, and III. Claims 71-86. Applicant traversed the restriction requirement, made a provisional election of claims 1-11 and 24-70, and requested reconsideration pursuant 37 C.F.R. 1.143 in a response submitted October 19, 2004. The examiner reconsidered the restriction requirement by joining groups I and III, but withdrawing claims 12-23 on group II, and holding the restriction requirement final in the Office action mailed on August 3, 2005.

Petitioner cites MPEP § 803 implying that no serious burden has been established for examining groups I and II. A review of the file reveals that claims 1-11 and 24-86 have been fully examined in an Examiner's Answer that has been forwarded to the Board of Patent Appeals and Interferences.

MPEP § 803 states:


“Under the statute, the claims of an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP §802.01, § 806.06, and §808.01) or distinct (MPEP §806.05 - §806.05(j)). If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.”

Since pending claims 1-11 and 24-70 have been fully examined for patentability, and that currently withdrawn claims 12-23 have been previously examined for patentability, there would not be a serious burden to the examiner to examine all pending claims 1-86 on the merits. The restriction requirement was deemed improper and claims 12-23 are reinstated.

The file has been forwarded to the examiner for consideration and for any further action consistent with this decision.

Summary: The petition is **GRANTED**.

Any questions regarding this decision should be directed to Supervisory Patent Examiner Matthew S. Gart at (571) 272-3955.



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lm
msg/lm: 12/28/2009